

## Remarks

### I. Introduction

This is in response to the Office Action dated September 23, 2003. The Office Action rejected claims 1, 2, 8, 9, 11, 13, 14 and 16-20 under 35 U.S.C. §102(e) as being anticipated by U.S. Pub. No. US 2003/0007625 A1 (Pines et al.). Claims 3-5 were rejected under 35 U.S.C. §103(a) as being unpatentable over Pines et al. in view of U.S. Patent No. 6,026,156 (Epler et al.). Claim 6 was rejected under 35 U.S.C. §103(a) as being unpatentable over Pines et al. in view of U.S. Patent No. 6,397,184 (Walker). Claims 7 and 10 were rejected under 35 U.S.C. §103(a) as being unpatentable over Pines et al. in view of U.S. Pub. No. US 2002/0059144 A1 (Meffert et al.). Claims 12 and 15 were rejected under 35 U.S.C. §103(a) as being unpatentable over Pines et al. in view of U.S. Patent No. 6,229,880 (Reformato et al.).

The specification has been amended to correct several typographical errors.

### II. Cited Art from Parent Application

This application is a continuation-in-part of U.S. Patent Application Ser. No. 09/609,893, filed July 5, 2000. Applicants request that the Examiner consider the prior art cited in the parent application and indicate in the next communication that such art has been considered as set forth in MPEP §2001.06(b). As such, applicants are not providing a separate citation of the prior art in the earlier application.

### III. The Pending Claims are Patentable Over the Cited Art

Claims 1, 2, 8, 9, 11, 13, 14 and 16-20 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Pub. No. US 2003/0007625 A1 (Pines et al.).

In order for a claim to be anticipated under 35 U.S.C. §102, **each and every** limitation of the claim must be found either expressly or inherently in a single prior art reference. PIN/NIP, Inc. v. Platte Chem. Co., 304 F.3d 1235, 1243 (Fed. Cir. 2002). In the present case, Pines et al. does not show each and every limitation of claims 1, 2, 8, 9, 11, 13, 14 and 16-20. Therefore, Applicants request the withdrawal of the rejection under 35 U.S.C. §102(e).

The present invention is generally directed to methods for identifying users over a network using an audible signature, personal sound identifier, or sound ID, which refer to one or more short or abbreviated sound snippets or a selection of notes, tunes, themes, or melodies which identifies one user to other users. The invention is more particularly set forth in pending claims 1 – 20 which particularly point out and distinctly claim that which applicants consider as their invention. Pines et al. is directed to a system and method which allows a requester to contact a communication apparatus user and to a system and method which provides wireless directory and other information assistance services. For the reasons discussed below, Pines et al. does not anticipate the presently claimed invention under the strict §102 standard as set forth above.

Independent claim 1 is directed to a method for identifying users over a network. In accordance with claim 1, a message from a first user is provided to at least one message recipient, and "the first user's sound ID is played ... upon delivery of the message...". Thus, the claim requires a "message" as well as a "sound ID". The Office Action indicates that it considers the term "caller" in Pines et al. equivalent to the "user" in the claim, and it considers the term "subscriber" in Pines et al. equivalent to the "message recipient" in the claim. The Office Action also cites two portions of Pines et al. as rendering claim 1 anticipated, paragraphs [0025] and [0148]. Paragraph [0025] of Pines et al. discloses a pre-announcement which identifies the caller so that the subscriber may accept or reject the call. Pines et al. gives the example of a text pre-announcement of the phone number of the caller. Paragraph [0148] is directed to the same pre-announcement function so that the subscriber can determine whether or not to accept the call. Using the framework of Pines et al. and the term equivalency of the Examiner, it must be assumed that the Examiner is rejecting claim 1 by considering the pre-announcement of Pines et al. equivalent to the sound ID of claim 1. While Applicants do not agree with this interpretation, even assuming this interpretation is correct, Pines et al. does not anticipate claim 1 because there is no "message" disclosed in Pines et al. Thus, even if the pre-announcement delivered to the wireless subscriber is considered a "sound ID", there is no delivery of a "message" along with the "sound ID". For this reason, Pines et al. fails to teach each and every limitation of claim 1, and therefore claim 1 is not anticipated by Pines et al.

One possible argument against the preceding paragraph is that the phone call itself is equivalent to the “message” of claim 1. While Applicants do not agree with such an interpretation, even if it was assumed for the moment that the phone call itself is equivalent to the “message” of claim 1, Pines et al. still does not anticipate claim 1.

Claim 1 contains the limitation of,

**“when the message is provided to the at least one message recipient, the first user’s sound ID is played for the at least one message recipient upon delivery of the message ...”.**

In accordance with claim 1 the sound ID is played upon delivery of the message. This is distinct from the Pines et al. technique in which the pre-announcement is provided and then the subscriber may decide whether or not to accept the call. Thus, even applying the assumed term equivalencies, in Pines et al. the sound ID (pre-announcement) is played separate and apart from the message (phone call) and in fact the message may never be transmitted to the subscriber. To the contrary, in claim 1, the sound ID is played “when the message is provided to the ... message recipient” and the “sound ID is played ... upon delivery of the message...”. Again, since Pines et al. does not disclose each and every claim limitation of claim 1, claim 1 is allowable over Pines et al.

Further, claim 1 is allowable over Pines et al. because Pines et al. does not disclose the claimed limitation of,

**“the sound ID having been previously selected by the first user for identifying the first user to the at least one message recipient”**

There is nothing in cited paragraphs [0025] and [0148] directed to this limitation. Although not cited by the Examiner in connection with claim 1, Applicants note that the Examiner has cited paragraph [0019] in connection with a similar limitation in other claims. As such, Applicants will address paragraph [0019] here. First, paragraph [0019] is directed to a “closing prompt”, not a pre-announcement. The closing prompt is provided to a requester after some service has been provided to the requester. However, the closing prompt does not identify the requester. Further, the closing prompt is not selected “by” the requested, but instead is selected “for” the requester. These are important distinctions and they render claim 1 allowable over Pines et al.

Independent claim 9 is also allowable over Pines et al. The first limitation of claim 9 is directed to “receiving a plurality of audible signature selections from a plurality of users” with “each user selecting a unique audible signature ...”. As discussed above, Pines et al. does not disclose the selection of audible signatures by users. The Office Action cites Pines et al. at paragraphs [0019], [0025] and [0148] as disclosing this limitation. However, there is nothing in paragraphs [0025] and [0148] directed to this limitation. Further, as described above, paragraph [0019] is directed to a “closing prompt”, not a pre-announcement, and the closing prompt does not identify a user. Further, the closing prompt is not selected “by” a user, but instead is selected “for” a user. For these reasons, Pines et al. cannot anticipate claim 9.

Further, claim 9 is allowable because there is no disclosure of “each communication is accompanied by the unique audible signature of the user which initiated the communication”. For the reasons discussed above in connection with claim 1, in Pines et al. the pre-announcement is sent separate and apart from the communication, and in fact there may be no communication if the subscriber declines to accept the call. Therefore, the communication in Pines et al. is not accompanied by the audible signature as required by claim 9. For this additional reason, Pines et al. does not anticipate claim 9.

Independent claim 16 is also allowable over Pines et al. Claim 16 contains the limitation of “providing a selection facility for receiving user selections of audible sound identifiers”. Pines et al. does not disclose this limitation. The Office Action cites Pines et al. at paragraphs [0019], [0025] and [0148] as disclosing this limitation. However, there is nothing in paragraphs [0025] and [0148] directed to this limitation. Further, as described above, paragraph [0019] is directed to a “closing prompt”, not a pre-announcement, and the closing prompt does not identify a user. Further, the closing prompt is not selected “by” a user, but instead is selected “for” a user. Further, there is nothing in Pines et al. disclosing a “selection facility” for receiving user selections. For these reasons, Pines et al. cannot anticipate claim 16.

For the reasons discussed above, independent claims 1, 9 and 16 are allowable over Pines et al. All remaining claims are dependent upon an allowable independent

claim and are therefore also allowable. In addition, the dependent claims add additional patentable subject matter and are allowable for the additional reasons discussed below.

Dependent claim 2 contains the limitation that “the message received from the first user is an instant messaging communication”. The Office Action cites Pines et al. at paragraphs [0025], [0047] and [0148] as disclosing this limitation. Paragraphs [0025] and [0148] disclose a pre-announcement that may be provided as a text message. However, a text message is not the same as an instant message. As is well known, and as described in the specification at page 1, lines 27-29, instant messages offer substantially real time interactive communication between users. The mere disclosure of a text message does not disclose instant messaging. Paragraph [0047] discloses that a wireless apparatus may be an instant messaging device. However, this does not disclose the claimed limitation in which the message itself is an instant message. For these reasons, Pines et al. does not anticipate claim 2.

Dependent claims 3 and 12 contain limitations directed to the message or communication being an activity status message or update. The Office Action admits that Pines et al. does not disclose an activity status message or an activity status update. In rejecting claim 3, the Office Action cites Epler et al. as disclosing distinctive ringing and indicates that distinctive ringing is a disclosure of an activity status update. As set forth in the cited portion of Epler et al., distinctive ringing allows a user to have multiple telephone numbers associated with a given line and the telephone(s) connected to the line ring distinctively depending upon the number called. Distinctive ringing does not indicate the activity status of a user that sent a message to the receiving device. Therefore, Epler et al. does not provide the missing disclosure. In rejecting claim 12, the Office Action cites Reformato et al. as disclosing the missing disclosure of an “activity status update”. The cited portion of Reformato et al. discloses updating a database to reflect changes in the status information associated with a subscriber. However, claims 3 and 12 are directed to a “communication” or “message” which indicates an activity status. Reformato et al. does not disclose such a communication or message to other users and therefore does not provide the missing disclosure.

Dependent claims 4 and 5 are dependent upon claim 3 and are therefore also allowable. Claim 5 adds the limitation that the activity alert sound alerts the message

recipient that the first user has become active on a device. The Office Action cites the pre-announcement of Pines et al. at paragraphs [0025] and [0148]. These paragraphs and the pre-announcement have been discussed above. With respect to claim 5, it is noted that the pre-announcement of Pines et al. indicates the identity of a caller calling a subscriber. It does not, as required by claim 5, alert the subscriber that the caller has become active on a device. For example, the caller may become active long before calling the subscriber, and in accordance with Pines et al., the subscriber would not be notified of the caller becoming active. The subscriber is only notified when the caller calls the subscriber. For this reason, claim 5 is not anticipated by Pines et al.

Claim 6 further limits the sound ID to being a “snippet of notes”. The Office Action admits that Pines et al. fails to disclose this limitation. The Office Action relies on Walker as supplying the missing disclosure. Walker is an invention in the photographic art and is directed to associating audio descriptions with photographs. Clearly, the photography art is non-analogous to the network communications art. As such, it is improper to rely on Walker as a reference. The Court of Appeals for the Federal Circuit has addressed the issue of non-analogous art and has set forth the standard as follows. In order to rely on a reference as a basis for rejection of an invention, the reference must either be in the field of the invention’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. In re Oetiker, 977 F.2d 1443, 1447 (Fed. Cir. 1992). Common sense must be used in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor. Id. The combination of elements from nonanalogous sources, in a manner that reconstructs the invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness. Id. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. Id. That knowledge cannot come from the Applicant's invention itself. Id.

In the present case, it is clear that an inventor working in the area of network communications would not reasonably be expected to look for a solution to a problem in the photographic arts. The motivation to search the patent database for the terms “snippet of notes” would only occur after having knowledge of the claimed invention of claim 6

and using impermissible hindsight. An inventor, working on the problem of data network communications, would not have any motivation to look to the photographic arts for a solution. As such, the reliance on Walker is impermissible. For these reasons, claim 6 is allowable.

Claim 7 further limits the sound ID to being a “at least a portion of a popular song”. The Office Action relies on Meffert et al. as supplying the missing disclosure. Meffert et al. is an invention directed to secure content delivery using encryption. For reasons similar to those described above in connection with the Walker reference, Meffert et al. is in a different field of endeavor and there would be no motivation of one skilled in the art to look to the encryption/content delivery art for a solution to a network communication problem. Further, even if Meffert et al. was considered to be in an analogous art, there is no motivation, except with impermissible hindsight, to combine Meffert et al. with Pines et al. The Office Action states that Meffert et al. “teaches that the sound ID is at least a portion of a popular song”. However, this is an incorrect characterization of Meffert et al. The cited portion of Meffert et al. teaches encrypting songs, or trial portions of songs, for secure content delivery. This is very different from using a portion of a song as a sound ID in accordance with claim 7. Thus, claim 7 is allowable over the cited art.

Claim 8 contains the limitation of “playing the first user’s sound ID followed by the message, the message being a text instant message”. The Office Action rejected claim 8 as anticipated by Pines et al. However, claim 8 is not anticipated by Pines et al. for the reasons discussed above in connection with claims 1 and 2.

Claim 10 contains the limitation that the “audible signature is a portion of a song”. The Office Action rejected claim 10 in reliance on Meffert et al. Claim 10 is allowable for the same reasons as discussed above in connection with claim 7.

Claim 11 contains the limitation of “wherein the users receiving the message is played the audible signature of the user which initiated the communication followed by the playing of the actual communication”. The Office Action rejected claim 11 as anticipated by Pines et al. However, claim 11 is not anticipated by Pines et al. for the reasons discussed above in connection with claims 1, 2 and 8.

Claim 13 contains the limitation of “providing a selection of audible signatures for selection by the plurality of users”. Claim 13 is allowable for the same reasons as discussed above in connection with claim 16.

Claim 14 contains the limitation of “wherein two or more of the plurality of users are prevented from selecting the same audible signature”. There is no such disclosure in the cited portion of Pines et al. and therefore Pines et al. cannot anticipate claim 14.

Claim 15 contains the limitation of “wherein the audible signature is preceded by an activity signal, the activity signal based upon the activity level of the initiating user”. Claim 15 is allowable for the reasons discussed above in connection with claim 12.

Claim 17 contains the limitation of “wherein the selection facility comprises a plurality of audible sound identifiers organized into categories. The Office Action rejected this claim as anticipated by Pines et al. For reasons set forth above, paragraphs [0019], [0025] and [0148] do not disclose this limitation. The Office Action, in rejecting claim 17, also cites paragraph [0020] as disclosing this limitation. Paragraph [0020] is directed to providing additional services to the subscribers. The mere mention of the word “category” does not disclose the claimed limitation of “audible sound identifiers organized into categories”. Claim 17 is allowable over Pines et al.

Claim 18 contains the limitation of “wherein users are allowed to create their own audible sound identifiers for inclusion in the selection facility”. There is no disclosure in the cited portions of Pines et al. for allowing users to create their own sound identifiers. Claim 18 is allowable over Pines et al.

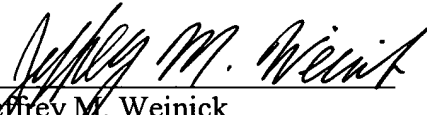
#### IV. Conclusion

It is noted that many of the arguments set forth above include the assertion that the cited portion(s) of a reference does not show the claimed limitations. If the Examiner persists in these rejections, Applicants respectfully request that, in order to advance the prosecution of this application, the Examiner specifically indicate particular portions of the cited paragraphs which disclose the claimed subject matter. This will allow Applicants to more particularly respond to the Examiner’s rejections and advance the prosecution of the application.



For the reasons discussed above, pending claims 1-20 are allowable over the cited art. Reconsideration and allowance of all pending claims is requested.

Respectfully submitted,

  
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